

**REMARKS:**

Claims 1-20 are currently pending in the subject Application.

Claims 1-6, 10-16, 19, and 20 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 6,012,046 to Lupien et al. ("*Lupien*").

Claims 7-9, 17, and 18 stand rejected under 35 U.S.C. § 103(a) over *Lupien* in view of U.S. Patent No. 6,408,282 to Buist ("*Buist*").

A Final Office Action in the subject Application was mailed to the undersigned on 4 May 2007, which provided for a response period ending 4 August 2007. The Applicant filed an Amendment After Final on 16 June 2007, within two (2) months of the date of the Final Office Action. An Advisory Action was mailed to the undersigned on 13 July 2007. The Advisory Action stated that the proposed Amendments filed on 16 June 2007 will not be entered because they raise new issues that require further consideration and/or search. (13 July 2007 Advisory Action, Page 1). The Applicant respectfully reiterates here the arguments set forth in the Amendment After Final filed on 16 June 2007, as if fully set forth herein.

The Applicant respectfully submits that all of Applicant's arguments and amendments are without prejudice or disclaimer. In addition, the Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, the Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. The Applicant further respectfully submits that by not responding to additional statements made by the Examiner, the Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by the Applicant are considered sufficient to overcome the Examiner's rejections. In addition, the Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

### **REJECTION UNDER 35 U.S.C. § 101:**

The Applicant thanks the Examiner for withdrawing the rejection of Claims 11 and 20 under 35 U.S.C. § 101.

### **REJECTION UNDER 35 U.S.C. § 102(b):**

Claims 1-6, 10-16, 19, and 20 stand rejected under 35 U.S.C. § 102(b) over *Lupien*.

Although the Applicant believes claims 1-20 are directed to patentable subject matter without amendment, the Applicant has amended independent Claims 1, 10-14, 19, and 20 to more particularly point out and distinctly claim the Applicant's invention. By making these amendments, the Applicant does not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 102(b), as set forth in the Office Action.

The Applicant respectfully submits that the ***amendments to independent Claims 1, 10-14, 19, and 20 have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims***. The Applicant further respectfully submits that amended independent Claims 1, 10-14, 19, and 20 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Lupien*. Thus, the Applicant respectfully traverses the Examiner's rejection of Claims 1-32 under 35 U.S.C. § 102(b) over *Lupien*.

### ***Lupien Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims***

For example, with respect to amended independent Claim 1, this claim recites:

***A system for generating a display of at least one side of a market***, the system comprising a computer system having one or more computers and operable to:

***receive market data reflecting one or more offers, from one or more market participants, each offer comprising at least an offered price and an offered quantity;***

generate a display of the received market data, the display comprising a price axis, a quantity axis, and one or more offer bars, each offer bar representing one or more offers comprising substantially equal offered prices, placement of an offer bar along the price axis representing the substantially equal offered prices for the one or more offers represented by the offer bar, height of an offer bar relative to the quantity axis representing an aggregate offered quantity for the one or more offers represented by the offer bar;

access an average price specified by a user;

calculate an offered quantity available at the specified average price based on the received market data; and

**indicate the calculated offered quantity within the display of the received market data.** (Emphasis Added).

In addition, *Lupien* fails to disclose each and every limitation of amended independent Claims 1, 10-14, 19, and 20.

The Applicant respectfully submits that *Lupien* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a “**system for generating a display of at least one side of a market**” and in particular *Lupien* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding “**receiv[ing] market data reflecting one or more offers, from one or more market participants, each offer comprising at least an offered price and an offered quantity**”. In particular, the Examiner equates “**receiv[ing] market data**” recited in amended independent Claim 1 with a “**satisfaction density profile**” disclosed in *Lupien*. (4 May 2007 Final Office Action, Page 2). However, **the satisfaction density profile disclosed in Lupien** is merely a two-dimensional grid, but **does not include, involve, or even relate to receiving market data**, as recited in amended independent Claim 1. (Column 6, Lines 47-59). In contrast, “**receiv[ing] market data**” recited in amended independent Claim 1 **reflects one or more offers, from one or more market participants, each offer comprising at least an offered price and an offered quantity**. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Lupien* and amended independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Lupien*.

In addition, the Examiner further clarifies that the Examiner's rejection with regard to *Lupien* is not necessarily equating "**receiv[ing] market data**" recited in amended independent Claim 1 with the **satisfaction density profile**" disclosed in *Lupien*, but instead with Figures 2 and 4 in *Lupien*. (13 July 2007 Advisory Action, Page 2). In particular, the Examiner states that Figure 2 of *Lupien* shows the **satisfaction density profile** is a two dimensional grid, wherein price is represented on the vertical axis and quantity is represented on the horizontal axis. In addition, the Examiner asserts:

Fig. 2 shows that the trader is fully willing to buy 100,000 at \$99.50, but **under no circumstances** is willing to buy the same quantity at \$100.125, or any quantity at \$101.00 (see column 6, line 47-column 7, line 5 of *lupine et al.*) *Lupien et al.* also teaches the orders are entered in the form of a satisfaction density profile that represents a degree of satisfaction to trade a particular instrument at various (price, quantity) combinations (see abstract). (13 July 2007 Advisory Action, Page 2). (Emphasis Added).

However, the Applicant respectfully submits that not only does *Lupien* fail to teach, suggest, or even hint at Applicant's claimed invention, but ***Lupien actually teaches away from Applicant's Claimed invention***. For example, the Applicant respectfully submits that, as acknowledged by the Examiner, the "**under no circumstances**" disclosure of *Lupien* makes clear that "**under no circumstances**" is the trader of *Lupien* willing buy above or below a set value. In addition, the "**under no circumstances**" disclosure of *Lupien* **does not include, involve, or even relate to receive market data reflecting one or more offers**, as recited in amended independent Claim 1. (Column 6, Line 47 through Column 7 Line 5).

In contrast, as discussed above, "**receiv[ing] market data**" recited in amended independent Claim 1 **reflects one or more offers, from one or more market participants, each offer comprising at least an offered price and an offered quantity**. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Lupien* and amended independent Claim 1 cannot be

made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Lupien*.

The Applicant respectfully submits that *Lupien* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding ***“indicat[ing] the calculated offered quantity within the display of the received market data”***. In particular, the Examiner equates ***“indicat[ing] the calculated offered quantity”*** recited in amended independent claim 1 with ***“some other statistic relating to the satisfaction values”*** disclosed in *Lupien*. (4 May 2007 Final Office Action, Page 4). However, ***“some other statistic relating to the satisfaction values” disclosed in Lupien*** is merely “available for output to a trader (e.g., minimum, average, medium, most frequently occurring, etc.), and ***does not include, involve, or even relate to indicat[ing] the calculated offered quantity***, as recited in amended independent Claim 1. (Column 12, Lines 7-14). In fact, this output, such as, for example, minimum, average, etc. has nothing to do with a ***“calculated offered quantity”*** as recited in amended independent Claim 1, and even if it did, which it clearly does not, ***merely making an output available to a trader***, as disclosed in *Lupien*, has nothing to do with ***“indicat[ing] the calculated offered quantity within the display of the received market data”***, as recited in amended independent Claim 1. In contrast, ***“indicat[ing] the calculated offered quantity”*** recited in amended independent Claim 1 ***is provided for indicating the calculated offered quantity within the display of the received market data***. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Lupien* and amended independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Lupien*.

### **The Office Action Fails to Properly Establish a *Prima Facie* case of Anticipation over *Lupien***

The Applicant respectfully submits that the allegation in the present Office Action that *Lupien* discloses all of the claimed features is respectfully traversed. Further, it is noted that the Office Action provides no concise explanation as to how *Lupien* is

considered to anticipate all of the limitations in amended independent Claims 1-6, 10-16, 19, and 20. ***A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.*** MPEP § 2131. (Emphasis Added).

With respect to the subject application, the Examiner has not adequately supported the rejection under 35 U.S.C. § 102, because the Examiner has not shown how each and every element of the Applicants claimed invention is identically shown in *Lupien*. For example, the Examiner asserts that “***receiv[ing] market data***”, in amended independent Claim 1 is somehow equivalent to a ***satisfaction density profile***. (4 May 2007 Final Office Action, Page 2). The Applicant respectfully disagrees and further respectfully requests clarification as to how the Examiner arrives at this conclusion. In another example, the Examiner asserts that “***receiv[ing] market data***”, in amended independent Claim 1 is somehow equivalent to Figures 2 and 4 in *Lupien*. (13 July 2007 Advisory Action, Page 2). The Applicant respectfully disagrees and further respectfully requests clarification as to how the Examiner arrives at this conclusion. In still another example, the Examiner asserts that “***indicat[ing] the calculated offered quantity***”, in amended independent Claim 1 is somehow equivalent to ***some other statistic relating to the satisfaction values***. (4 May 2007 Final Office Action, Page 4). The Applicant respectfully disagrees and further respectfully requests clarification as to how the Examiner arrives at this conclusion.

The Applicant respectfully points out that "it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicant respectfully submits that ***the Office Action has failed to establish a prima facie case of anticipation in Claims 1-6, 10-16, 19, and 20 under 35 U.S.C. § 102 with respect to Lupien because Lupien fails to identically disclose each and every element of the Applicant's claimed invention, arranged as they are in Applicant's claims.***

## **The Applicant's Claims are Patentable over *Lupien***

With respect to amended independent Claims 10-14, 19, and 20, these claims are considered patentably distinguishable over *Lupien* for at least the reasons discussed above in connection with amended independent Claim 1.

Furthermore, with respect to dependent Claims 2-6, 15, and 16: Claims 2-6 depend from amended independent Claim 1 and dependent Claims 15 and 16 depend from amended independent Claim 14 are also considered patentably distinguishable over *Lupien*. Thus, dependent Claims 2-6, 15, and 16 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicant respectfully submits that Claims 1-6, 10-16, 19, and 20 are not anticipated by *Lupien*. The Applicant further respectfully submits that Claims 1-6, 10-16, 19, and 20 are in condition for allowance. Thus, the Applicant respectfully request that the rejection of Claims 1-6, 10-16, 19, and 20 under 35 U.S.C. § 102(b) be reconsidered and that Claims 1-6, 10-16, 19, and 20 be allowed.

## **THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:**

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.
2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.



4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the Claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things

co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

#### **REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 7-9, 17, and 18 stand rejected under 35 U.S.C. § 103(a) over *Lupien* in view of *Buist*.

Although the Applicant believes claims 1-20 are directed to patentable subject matter without amendment, the Applicant has amended independent Claims 1, 10-14, 19, and 20 to more particularly point out and distinctly claim the Applicant's invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicant respectfully submits that the ***amendments to independent Claims 1, 10-14, 19, and 20 have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims.*** The Applicant further respectfully submits that amended independent Claims 1, 10-14, 19, and 20 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Lupien* or *Buist*, either individually or in combination, fail to disclose, teach, or suggest each and every element of Claims 7-9, 17, and 18. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of Claims 7-9, 17, and 18.

under 35 U.S.C. § 103(a) over the proposed combination of *Lupien* or *Buist*, either individually or in combination.

**The Proposed *Lupien-Buist* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 7-9, 17, and 18**

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Lupien* fails to disclose various limitations in dependent Claim 7. Specifically, the Examiner acknowledges that *Lupien* fails to disclose “access an approved market participant list; adjust the heights of one or more offer bars to reflect one or more market participants being excluded from the approved market participant list; and calculate the offered quantity available at the specified average price based on the approved market participant list in addition to the received market data.” (4 May 2007 Final Office Action, Page 14). However, the Examiner asserts that the cited portions of *Buist* disclose the acknowledged shortcomings in *Lupien*. The Applicant respectfully traverses the Examiners assertions regarding the subject matter disclosed in *Buist*.

The Applicant further respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Lupien* fails to disclose various limitations in dependent Claim 8. Specifically, the Examiner acknowledges that *Lupien* fails to disclose “the offer bars comprise ask bars” and “the approved market participant list comprises an approved seller list”. (4 May 2007 Final Office Action, Page 16). However, the Examiner asserts that the cited portions of *Buist* disclose the acknowledged shortcomings in *Lupien*. The Applicant respectfully traverses the Examiners assertions regarding the subject matter disclosed in *Buist*.

The Applicant still further respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Lupien* fails to disclose various limitations in dependent Claim 9. Specifically, the Examiner acknowledges that *Lupien* fails to disclose that the computer system is further operable to divide each of the offer bars into one or more bar segments, each bar segment corresponding to a particular offer from a particular market participant. (4 May 2007 Final Office Action, Page 16).

However, the Examiner asserts that the cited portions of *Buist* disclose the acknowledged shortcomings in *Lupien*. The Applicant respectfully traverses the Examiners assertions regarding the subject matter disclosed in *Buist*.

The Applicant yet further respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Lupien* fails to disclose various limitations in dependent Claim 17. Specifically, the Examiner acknowledges that *Lupien* fails to disclose that the computer system is further operable to “calculate a first offered quantity and a second offered quantity, the first calculated offered quantity comprising a quantity available at the specified average price independent of the approved market participant list, the second calculated offered quantity comprising a quantity available at the specified average price taking into account the approved market participant list, the first calculated offered quantity being greater than or equal to the second calculated offered quantity; and indicate the first and second calculated offered quantities within the display of the received market data.” (4 May 2007 Final Office Action, Page 17). However, the Examiner asserts that the cited portions of *Buist* disclose the acknowledged shortcomings in *Lupien*. The Applicant respectfully traverses the Examiners assertions regarding the subject matter disclosed in *Buist*.

The Applicant further respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Lupien* fails to disclose various limitations in dependent Claim 18. Specifically, the Examiner acknowledges that *Lupien* fails to disclose that the computer system is further operable to receive new market data reflecting one or more changes in the one or more offers and in response to receiving the new market data, update the display of the market data. (4 May 2007 Final Office Action, Page 18). However, the Examiner asserts that the cited portions of *Buist* disclose the acknowledged shortcomings in *Lupien*. The Applicant respectfully traverses the Examiners assertions regarding the subject matter disclosed in *Buist*.

The Applicant respectfully submits that *Buist* fails to disclose, teach, or suggest the limitations recited in dependent Claims 7-9, 17, and 18. Rather *Buist* discloses a system and method to support trading of securities over the Internet. (Abstract).

However, *Buist* fails to teach, suggest, or even hint at a “**system for generating a display of at least one side of a market**”, as claimed in dependent Claims 7-9, 17, and 18.

### **The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Lupien-Buist* Combination**

The Applicant respectfully submits that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Lupien* or *Buist*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that “it would be a *prima facie* obvious to one of ordinary skill in the art at the time the invention was made” to add market participant list” and (1) “adjust the heights of one or more offer bars; (2) “offer bars comprise ask bars”; (3) “the first and second calculated offered quantities features”; and (4) “to add receive new market data reflecting one or more changes in the one or more offers and update display of the market data features to the system of *Lupien*” (4 May 2007 Final Office Action, Pages 14-18). The Applicant respectfully disagrees.

The Applicant further respectfully submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Lupien* or *Buist*, either individually or in combination. The Examiner asserts that the motivation to combine the references as proposed would be “because *Buist* teaches that adding market participant list helps supports an improved human interface and provides faster access to critical information”. (4 May 2007 Final Office Action, Pages 14-18). The Applicant respectfully disagrees and further respectfully requests clarification as to how the Examiner arrives at this conclusion. For example, how does an “improved human interface” provide “faster access to critical information” and to what extent does the Examiner purport that this “user interface” or this “critical information” applies to the subject Application. ***The Applicant respectfully requests the examiner to point to the portions of Lupien or Buist which contain the teaching, suggestion, or motivation to combine these references for the***

**for the Examiner's stated purported advantage.** The Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the **prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, **the Examiner has not adequately supported the selection and combination of Lupien and Buist to render obvious the Applicant's claimed invention.** The Examiner's above-cited conclusory statements **do not adequately address the issue of motivation to combine.** (4 May 2007 Final Office Action, Pages 14-18). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, **the Office Action fails to provide proper motivation for combining the teachings of Lupien or Buist**, either individually or in combination.

### **The Applicant's Claims are Patentable over the Proposed *Lupien-Buist* Combination**

The Applicant respectfully submits that amended independent Claims 1, 10-14, 19, and 20 are considered patentably distinguishable over the proposed combination of *Lupien* and *Buist*. This being the case, amended independent Claims 1, 10-14, 19, and 20 are considered patentably distinguishable over the proposed combination of *Lupien* and *Buist*.

With respect to dependent Claims 7-9, 17, and 18: Claims 7-9 depend from amended independent Claim 1 and Claims 17 and 18 depend from amended independent Claim 14. As mentioned above, each of amended independent Claims 1, 10-14, 19, and 20 are considered patentably distinguishable over *Lupien* and *Buist*. Thus, dependent Claims 7-9, 17, and 18 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant respectfully submits that Claims 7-9, 17, and 18 are not rendered obvious by the proposed combination of *Lupien* and *Buist*. The Applicant further respectfully submits that Claims 7-9, 17, and 18 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 7-9, 17, and 18 under 35 U.S.C. § 103(a) be reconsidered and that Claims 7-9, 17, and 18 be allowed.

#### **THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, of making the



combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed in electronically herewith to facilitate the processing of this deposit account authorization. **The Director is hereby authorized to charge the \$790.00 RCE fee, to Deposit Account No. 500777.** Although the Applicant believes no additional fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777.** If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777.**

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

30 July 2007  
Date

/Steven J. Laureanti/signed  
Steven J. Laureanti, Registration No. 50,274

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**CUSTOMER NO. 53184**